

**REMARKS**

The following paragraph numbers correspond to the paragraph numbers of the Detailed Action of the Office Action dated August 15, 2003. Reconsideration of the application is respectfully requested.

1-2. Claims 1 and 3 have been amended. It appears that certain numbering was inadvertently altered during conversion by PASAT for electronic filing. It is submitted that all claims now comply with 35 USC 112.

3-4 Examiner has rejected all claims under 35 USC 102(a) as being anticipated by the Whitmyer reference. With respect, it is submitted that the Whitmyer reference fails to teach the invention claimed in the present application.

Whitmyer teaches an automated system of creating reminders for clients of upcoming deadlines, which includes a response form which is sent to the client. The response form includes means for indicating instructions which may then be completed and returned to the lawyer. The lawyer receives the completed response form and acts on the reply from the client.

The Whitmyer system is exemplified by a patent maintenance fee reminder system. The lawyer's computer includes a database of upcoming deadlines for paying the fees. In advance of the deadline, a reminder including a response form is generated and emailed to the client. The client completes the response form, indicating whether or not the maintenance fee should be paid. The completed response form is then sent back to the lawyer, who acts on the instructions.

In contrast, with the present invention, the system and process is controlled by the *client*, and *not the lawyer*. Upon being faced with retaining a lawyer, the client initiates the process by prompting the lawyer to complete a service order. The service order includes, at a minimum,

a description of the services to be provided and the estimated cost. The service order preferably further includes an estimate of the time to complete the services and the estimated or probable result. In effect, this is analogous to a client sending out a Request for Proposal (RFP) to which a lawyer would return a proposal. The client may then receive the service order proposal and either approve or disapprove of it. The legal retainer is not complete until the client approves the service order. Upon approval (or disapproval), the lawyer is notified.

In the Whitmyer reference, the lawyer initiates the process by sending a reminder note to the client which requires the client provide instructions to the lawyer. In the present application, the client initiates the process by requesting the lawyer to prepare and submit a service order which identifies the services requested and an estimated cost, estimated time to complete, and estimated results. The client may then use the cost, time and result estimates as a tool to decide whether to approve or disapprove, and to gauge the lawyer's performance with respect to legal fees.

It is a critical difference that in Whitmyer, the lawyer controls the process and the process essentially automates a legal service which is provided to the client. In the present invention, the client controls the process, which automates the process of retaining and managing legal services.

As a result of this fundamental difference, the steps of the claimed method are different. In the present invention, the first step is an invitation by the client to a lawyer for the lawyer to submit a proposal. In the Whitmyer reference, the first step is a reminder of a due date sent by the lawyer to the client. A second step in the present invention is the submission of a service order (proposal) by the lawyer. The second step in Whitmyer is the submission of instructions by the client to the lawyer. In other words, the present invention is the *complete inverse* of the Whitmyer invention.

5. Examiner has rejected the claims under 35 USC 102(e) as being anticipated by the Metlzer reference. With respect, it is submitted that the Metlzer reference fails to teach the invention claimed in the present application.

The Metlzer reference teaches an interrogative interface which allows a client to retain a lawyer via the Internet. Similar to the Whitmyer reference, the method and system is controlled by the lawyer. In the Metlzer case, a client may complete an online form to provide the lawyer with sufficient information to perform legal services. This information is gathered by the lawyer, and stored in a database. The key difference is highlighted by the accessibility to this database. In Metlzer, there is an administration interface for accessing information in the database, *which is only accessible by the lawyer* [see column 3, lines 63-65].

In the present invention, the database of information which is built by service orders and other information given to the client by the lawyer, is maintained by the *client, not the lawyer*, and is *only accessible by the client*.

Therefore, the same distinction made above applies in this case. The Metlzer system is controlled by the lawyer and serves to automate the actual provision of legal services. In the present invention, the client controls the process. The claimed process in the present invention does not automate the actual provision of legal services. Instead, the process automates the retainer and management of legal services (of any kind, delivered in any fashion, by any legal service provider) for the client's benefit.

### CONCLUSION

In short, with the present invention, the client gains a measure of control and the traditional lopsided relationship with the lawyer is more balanced. In the prior art, exemplified by the Metlzer and Whitmyer references, the traditional patronizing lawyer-client relationship is

reinforced. This is a fundamental difference – demonstrating that the prior art does not anticipate or render the present invention obvious.

In view of the foregoing remarks and amendments, it is respectfully submitted that this application is in condition for allowance and allowance thereof is respectfully requested.

Respectfully submitted,

Richard Fraser

By: 

Edward Yoo (Reg. No. 41,435)

**CORRESPONDENCE ADDRESS:**

Customer No. 22828

Edward Yoo  
780.917.5231 (ph)  
780.421.7951 (fax)  
yoot@bennettjones.ca